

PATENT

Attorney Docket No. 40655.0100

REMARKS**I. Summary of the Presently Claimed Invention**

The presently claimed invention includes systems and methods for providing multiple-service cards. See, e.g. Specification Page 11, lines 19 through 32; Claims 1-19. The systems of Applicants' claimed invention include a card service engine that is configured to receive an application at a service partner establishment, where the application includes service partner information relating to membership in the service partner establishment. See, e.g. Specification Page 11, line 1 through Page 12, line 4; Claim 12, as amended. The method of Applicants' claimed invention similarly includes receiving an application at a service partner establishment, where, again, the application includes service partner information related at least in part to membership in the service partner establishment. See, e.g. Specification Page 11, lines 19 through 32; Claims 1 and 6, as amended. The receiving of an application for a multiple service card at a service partner establishment, as claimed in Applicants' instant application, provides consumers and cooperating service providers with advantages that were previously unavailable in the art. See, e.g. Specification Page 3, line 20 through Page 4, line 25; Page 4, line 25 through Page 5, line 12.

**II. Status of Claims**

Claims 1-19 were presented for examination. Claim 8 was objected to based on informalities. Claims 1-19 stand rejected under 35 U.S.C. §103. Applicants have amended independent claims 1, 6, and 12 and dependent claim 8. In addition Applicants have submitted new claims 20-29 for consideration.

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### III. Claim Objections

Claim 8 was objected to based on the informality of the term "membership0." The Examiner suggested substitution with -- membership --. Applicants have corrected claim 8 and respectfully request removal of this objection.

### IV. Rejections Under 35 U.S.C. § 103

Claims 1-19 stand rejected under 35 U.S.C. § 103 as being unpatentable over U.S. Pat. No. 5,969,318, which issued October 19, 1999 to Mackenthun ("the Mackenthun patent") in view of U.S. Pat. No. 6,032,136, which issued February 29, 2000 to Brake, et al. ("the Brake patent"). The Examiner admits that Mackenthun does not teach either the step of authorizing the credit card information, the step of communicating to the service partner, or the limitation that the multiple-service card is configured for providing a primary party's services and a service partner's services. The Examiner asserts, however, that Brake teaches the above limitations by verifying the customer's information before adding a secondary service to the primary service 25 and both primary feature/indicia 72 and secondary feature/indicia 74 present on the multiple service card. The Examiner contends that it would have been obvious to an artisan of ordinary skill in the art to incorporate the teachings of the Brake patent into the teachings of the Mackenthun patent to produce Applicants' claimed invention. For the following reasons, Applicants respectfully traverse the Examiner's grounds for rejection. Applicants respectfully submit that the cited references do not teach, hint, suggest, or disclose the elements of the present invention as disclosed and claimed.

With regard to the §103 rejections of Claims 1-19, "[i]t is impermissible to first ascertain factually what [applicant] did and then view the prior art in such a manner as to select from the random facts of that art only those which may be modified and then utilized to reconstruct [applicant's] invention from such prior art." *In re Shuman*, 361 F.2d 1008, 1012 (C.C.P.A. 1996). The present claims, as amended, define an invention that is not obvious over the Mackenthun patent, or the Brake patent taken singularly or in combination. The Office has not

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identified any reference, either singularly or in combination, that teaches, hints, suggests, or discloses the specific combination recited in the claims.

Specifically, Applicants have amended independent claim 1 to recite that the step of "receiving [is performed] at a service partner establishment" and to recite that the "service partner information [is] related at least in part to membership in the service partner establishment." Similarly, Applicants have amended independent claim 6 to recite that the step of "receiving [is accomplished] from a service partner establishment" and to also recite that the "service partner information [is] related at least in part to membership in the service partner establishment." Applicants respectfully submit that neither the Mackenthun patent nor the Brake patent discloses the step of receiving an application at, or from, a service partner establishment nor the limitation that the application includes service partner information related at least in part to membership in the service partner establishment.

Similarly, Applicants have amended independent claim 12 to recite that the "card service engine is configured to receive at a service partner establishment an application for a multiple-service card from a consumer, said application comprising credit card information and service partner information, said service partner information related at least in part to membership in the service partner establishment." Applicants respectfully submit that neither the Mackenthun patent nor the Brake patent discloses a card service engine that is configured to receive an application at a service partner establishment, where the application includes service partner information relating to membership in the service partner establishment.

In the Mackenthun patent, the card requester may access a service partner only through a gateway apparatus. See, e.g. the Mackenthun patent, FIGs 1-4; Col. 1, line 66 through Col. 2, line 5. Moreover, the gateway apparatus of the Mackenthun patent, while providing access to multiple card service providers, does not teach, hint, suggest, or disclose providing the card requester with access to services of membership in a service partner establishment, let alone the step of receiving an application for a multiple-service card from a consumer at a service partner establishment.

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Thus, even if the cited prior art references were combined, which Applicants argue there is no motivation to do except in hindsight, the combination would not produce Applicants' novel invention, and thus, cannot obviate it. Moreover, the Office Action fails to identify where, in any of the cited prior art references, the Mackenthun patent either should be or could be modified by the teachings in the Brake patent to achieve the present invention. Applicants were the first to recognize the advantage of receiving an application at a service partner establishment, where the application includes service partner information related at least in part to membership in the service partner establishment. The Office Action has not met its burden in establishing a prima facie case of obviousness. Therefore, reconsideration and withdrawal of these rejections are respectfully requested.

In sum, neither the Mackenthun patent nor the Brake patent discloses, teaches, hints, or suggests every element of claims 1, 6, and 12, so the rejection of these claims, and the rejection of claims 2-5, 7-11, and 13-19, which depend from claims 1, 6, and 12, is improper.

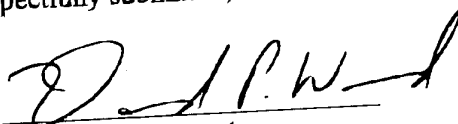
#### V. Conclusion

In review of the foregoing discussion, Applicants have responded to each and every rejection, and respectfully urges that the claims as presented are in condition for allowance. Reconsideration and withdrawal of the objection and rejections are respectfully requested. Applicants have provided better structural and procedural distinctions of the present invention by amending the claims and respectfully submit that no new subject matter has been introduced as a result of this amendment. Applicants respectfully submit that the foregoing discussion does not present new issues for reconsideration and that no new search is necessitated. As such, Applicants respectfully request the claims be entered and expeditiously processed to issuance. Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact the undersigned representative to conduct an interview in an effort to expedite prosecution in connection with the present application.

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Respectfully submitted,

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**VERSION OF CLAIMS WITH MARKINGS TO SHOW CHANGES MADE**

1. (Amended) A method for providing a multiple-service card, the method comprising the steps of:

receiving at a service partner establishment an application for a multiple-service card from a consumer, said application comprising credit card information and service partner information, said service partner information related at least in part to membership in the service partner establishment;

communicating said credit card information to a provider of credit services; and

causing a multiple-service card to be sent to the consumer, wherein said multiple-service card is configured for providing a primary party's services and a service partner's services.

6. (Amended) A method for providing a multiple-service card, the method comprising the steps of:

receiving from a service partner establishment an application for a multiple-service card from a consumer, said application comprising credit card information and membership card information, said membership card information related at least in part to membership in the service partner establishment;

authorizing said credit card information;

communicating said membership card information to a provider of membership services; and

causing a multiple-service card to be sent to the consumer.

8. (Amended) The method of claim 6 further comprising canceling a service partner membership[0], wherein said canceling comprises:

- transmitting a file comprising indicia of an account to be cancelled,
- producing a cancellation report, and
- producing a balancing report.

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12. (Amended) A system for providing a multiple-service card comprising:  
at least one service partner;  
a card service engine in communication with said at least one service partner; and  
at least one primary party in communication with said card service engine;  
wherein said at least one primary party provides a credit card service; [and]  
wherein said at least one primary party is capable of receiving data from, and  
transmitting data to, said card service engine; and  
wherein said card service engine is configured to receive at a service partner  
establishment an application for a multiple-service card from a consumer, said application  
comprising credit card information and service partner information, said service partner  
information related at least in part to membership in the service partner establishment.

20. (New) A multiple-service card associated with which there is a service partner, a  
primary party and a holder, the card comprising:  
a first side and a second side,  
the first side having first indicia associated with said primary party.  
the second side having second indicia associated with said service partner,

21. (New) The multiple-service card of claim 20, said primary party being a provider of  
credit services.

22. (New) The multiple-service card of claim 20, said service partner being a provider of  
membership club services.

23. (New) The multiple-service card of claim 20, said first indicia including an account  
number, a name of the holder, and an expiration date.

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24. (New) The multiple-service card of claim 20, said second indicia including a service partner membership number.

25. (New) The multiple-service card of claim 20, said second indicia including a magnetic stripe that contains account information in machine readable form.

26. (New) The multiple-service card of claim 20, said second indicia including a space for a signature.

27. (New) The multiple-service card of claim 20, said second indicia including a customer service number.

28. (New) The multiple-service card of claim 20, said second indicia including a barcode representing a service partner membership number.

29. (New) The multiple-service card of claim 20, said second indicia including an image of the card holder.